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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,159	03/28/2002	Richard McEwan	604.27-US1	6416

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EXAMINER	
BADII, BEHRANG	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,159	MCEWAN ET AL.	
	Examiner	Art Unit	
	Behrang Badii	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments with respect to claim 1-23 have been considered but are moot in view of the new ground(s) of rejection. The phrase "the commercial message including tracking software" is in condition for the new ground of rejection. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The claimed invention utilizes tracking software that is included with, or embedded within, the commercial message. Thus, when the commercial message is forwarded to another recipient, without having to go through a central sewer, the tracking software reports the forwarding activity.) are not recited in the rejected claim(s). This section should be clearly explained in the independent claim. That is, the independent claim should clearly state that it is only this tracking software included in the message that will keep track of the forwarding of the message by the recipient independent of any central mail server or any other central processing mechanism and the process should be fully described in the independent claim to show how and/or if this independent tracking mechanism will work. The new reference, Venkatraman et al. discloses a software being transmitted via email. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Walker explains rewarding of repeat customers. It is the rewarding mechanism of the Walker reference with is important and hence combining this aspect with the Leonard et al. reference.

DETAILED ACTION

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 5-9, and 11-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al., U.S. patent 6,721,784 and further in view of Venkatraman et al. U.S. patent application publication 2005/0021633 and Walker et al., U.S. patent 6,327,573.

4. As per claim 1 & 23, Leonard et al. discloses a method of virtual marketing comprising:

providing a commercial message in an electronic medium;

providing the commercial message to a recipient;

the recipient forwarding the commercial message to a later generation recipient;

electronically tracking an aspect of the recipient's forwarding of the commercial message (Abstract, Fig. 1, 9 and 17). Leonard et al. does not disclose a message which includes software or rewarding the recipient (customer). Venkatraman et al. discloses a message, which includes software (p37). Walker et al. discloses rewarding the recipient (customer) (col. 1, lines 46-52). It would have been obvious to modify Leonard et al. to include a message which includes software such as

that taught by Venkatraman et al and using the electronic tracking as a basis for rewarding the recipient (customer) for forwarding the commercial message such as that taught by Walker et al. in order to satisfy the customer such that the customer will refer others and the customer will also shop at this location in the future.

5. As per claim 5, Leonard et al. further discloses the message comprising a political message (col. 23, lines 50-54)

6. As per claim 6, Leonard et al. further discloses providing the message to the recipient comprises sending the message to the recipient via e-mail (Abstract, Fig. 1, 9 and 17).

7. As per claim 7, Leonard et al. further discloses forwarding the commercial message comprises sending the message to a later generation recipient via e-mail (Abstract, Fig. 1, 9 and 17).

8. As per claim 8, Leonard et al. further discloses wherein the recipient is a first generation recipient (Abstract, Fig. 1, 9 and 17).

9. As per claim 9, Leonard et al. further discloses forwarding comprises the recipient indirectly forwarding the commercial message by providing another entity with address of the later generation recipient, and the entity causing the forwarding to occur (Abstract, Fig. 1, 9 and 17).

10. As per claims 11-13, Leonard et al. further discloses step of forwarding comprising the recipient forwarding the commercial message without modification to the later generation recipient via e-mail and the step of forwarding comprising the recipient supplementing the commercial message and the step of forwarding comprising the

recipient modifying the commercial message (col. 7, lines 32-52; col. 9, lines 31-37; col. 10, lines 19-34; col. 18, lines 34-50; col. 20, lines 14-38 and 50-67; col. 21, lines 1-8; Fig. 13)

11. As per claim 14, Leonard et al. further discloses the step of tracking comprises tracking forwarding of the commercial message through at least two generations (Abstract, Fig. 1, 9 and 17).

12. As per claims 15 and 16, Leonard et al. further discloses the step of tracking comprises tracking forwarding of the commercial message through at least three (contiguous) generations (Abstract, Fig. 1, 9 and 17).

13. As per claim 17, Leonard et al. further discloses the aspect of the forwarding being tracked comprises a forwarding date and a forwarding address (Abstract, Fig. 1, 9 and 17).

14. As per claims 18 and 19, Leonard et al. further discloses a total number of later generation recipient to which the message has been forwarded (Abstract, Fig. 1, 9 and 17). Leonard et al. does not disclose a variation in rewarding the recipients (customers). Walker et al. does disclose a variation in rewarding the recipients (customers) (col. 1, lines 46-52). It would have been obvious to modify Leonard et al. to include a variation in rewarding the recipients (customers) such as that taught by Walker et al. in order to reward the customers based on the number of referrals the customer has done, such that to entice the customer to refer more potential customers in the future.

15. As per claim 20, Walker et al. further discloses the step of rewarding comprises providing a reward selected from the list consisting of redeemable points and e-money (col. 1, lines 32-47; col. 9, lines 55-67; col. 10, lines 1-11).

16. As per claims 21 and 22, Leonard et al. further discloses providing a report summarizing a forwarding history over multiple generations (col. 18, 34-50; Fig's. 7, 8, 9 and 17).

17. Claim 2-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al. in view of Walker et al. as applied to claim 1 above, and further in view of Treyz et al. As per claim 1, Leonard et al. in view of Walker et al. disclose a method for virtual marketing as described above. As per claim 2, Leonard et al. in view of Walker et al. do not disclose the message comprising an advertisement. Treyz et al. discloses the message comprising an advertisement (col. 50, lines 19-38; col. 58, lines 55-60). It would have been obvious to modify Leonard et al. to include an advertisement in the message such that taught by Treyz et al. in order to use the emails being forwarded as a vehicle for increasing the customer base.

18. As per claim 3 and 4, Treyz et al. further discloses a message comprising a company logo, which is also branded (col. 50, lines 19-38; col. 58, lines 55-60).

19. As per claim 10, Treyz et al. further discloses a portion of the message that includes an advertisement (col. 48, lines 13-22).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jones (U.S. patent 6,748,318) discloses an advanced notification systems and methods utilizing a computer network.

Tett (U.S. patent 6,633,756) discloses a System and method for tracking wireless messages originating from a single user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Hand delivered responses should be brought to

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(703) 306-5771**.

Behrang Badii
Patent Examiner
Art Unit 3621

BB

PRIMARY EXAMINER